



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/118,824 07/20/98 LEE

J

002292 LMC1/1221
BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

TRAN, T

ART UNIT

PAPER NUMBER

2712

DATE MAILED:

12/21/99

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/118,824

Applicant

Lee et al

Examiner

Thal Tran

Group Art Unit

2712



☒ Responsive to communication(s) filed on Sep 29, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-58 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2712

DETAILED ACTION

Oath/Declaration

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The oath or declaration must identify the foreign application on which foreign priority is being claimed by specifying the application number, country, day, month, and year of its filing as required by 37 CFR 1.63(c).

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-58 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Art Unit: 2712

Response to Arguments

4. Applicant's statements regarding the declaration filed Sept. 29, 1999 have been fully considered with the following response.

In re pages 5-6, applicants state the unexecuted Supplemental Declaration overcomes the deficiencies in the originally filed Reissue Declaration.

In response, it is agreed that the unexecuted Supplemental Declaration overcomes the deficiencies in the originally filed Reissue Declaration. Since the Supplemental Declaration is not executed, claims 1-58 are again rejected as being based upon a defective declaration under 35 U.S.C. 251 until the executed Supplemental Declaration is received.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37

Art Unit: 2712

CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 23-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naimpally ('993) in view of Enokida ('393) and Yuen et al ('409) as set forth in paragraph #5 of the last Office Action.

Naimpally discloses an apparatus for controlling recording in a digital recording device (Figs. 3 and 4) having an input unit (310 and 320 of Fig. 3) receiving digital video data; a detection circuit (310-316 of Fig. 3) coupled to the input unit and detecting specific data from the received digital video signal; a recording unit (VTR of Fig. 3) recording the digital video data as recited in claims 23 and 42; a reproducing unit (VCR of Fig. 4) for reproducing digital data stored on a digital medium, the digital data including a plurality of specific data; control circuit (432 of Fig. 4) receiving a command and outputting the specific data as recited in claims 33 and 52; wherein the specific data is I-frame data (314 of Fig. 3) as recited in claims 24, 35, 43, and 54; a timing signal generating circuit (328 of Fig. 3) generating a timing control signal; a multiplexer (318 of Fig. 3) coupled to the timing signal generating circuit and selectively outputting the detected specific data and the digital video data based on the timing control signal as recited in claims 25 and 44; a formatting circuit (316 and 322 of Fig. 3 and Fig. 5) forming

Art Unit: 2712

a synchronous block including video data as recited in claims 30 and 49; wherein the video data region are I-frame data regions (316 of Fig. 3 and Fig. 5) as recited in claims 31 and 50; wherein the recording unit records the synchronous block on the digital medium for each I-frame data region (VTR of Fig. 3) as recited in claims 32 and 51; wherein the reproducing unit includes a motor (VCR of Fig. 4) as recited in claim 39; and wherein the reproducing unit including reading heads (column 4, lines 4-7) and signal processing circuits (Fig. 4) as recited in claim 41. However, Naimpally does not specifically disclose a data generating circuit coupled to the detection circuit and generating a plurality of relative position data, each of the plurality of relative position data indicative of a plurality of relative positions from a current specific data location to each of a plurality of consecutive specific data location; that a recording unit records the plurality of relative position data on the digital medium as recited in claims 23 and 42; that the reproducing unit reproduces a plurality of relative position data; a detection circuit coupled to the reproducing unit and detecting one of the plurality of relative position data from the reproduced digital data; that a control circuit controls the reproducing unit to reproduce at least another specific data based on the detected relative position data as recited in claims 33 and 52; wherein the digital medium includes a magnetic medium as recited in claims 26 and 45; wherein each of the plurality of relative position data includes a plurality of distance indicators, each distance indicator indicating a distance between the current specific data location and one of the consecutive specific data location as recited in

Art Unit: 2712

claims 27, 36, 46, and 55; wherein the distance is represented with a number of distance units present between the current specific data location and one of the consecutive specific data locations as recited in claims 28, 37, 47, and 56; wherein the distance unit is a track on the storage medium as recited in claims 29, 38, 48, and 57; wherein the synchronous block includes one of the plurality of relative position data therein for each video data region as recited in claims 30 and 49; a decoding circuit selecting one of the relative positions represented in the detected relative position data based on the command as recited in claims 34 and 53; and a calculating circuit calculating a rotational speed of the motor based on the detected relative position data as recited in claims 40 and 58.

Enokida teaches a moving image processing apparatus having a data generating circuit (column 11, lines 5-36) coupled to the detection circuit and generating relative position data, the relative position data indicative of a plurality of relative positions from a current specific data location to each of a plurality of consecutive specific data location; a reproducing unit (Fig. 11A and its respective disclosure) reproducing the relative position data; a detection circuit (Fig. 11A and its respective disclosure) coupled to the reproducing unit and detecting the relative position data from the reproduced digital data; a control circuit (Fig. 11A and its respective disclosure) controlling the reproducing unit to reproduce at least another specific data based on the detected relative position data; wherein the relative position data includes a plurality of distance indicators, each distance indicator indicating a distance between the current specific data location and one of the

Art Unit: 2712

consecutive specific data location (columns 11-12); wherein the distance is represented with a number of distance units present between the current specific data location and one of the consecutive specific data locations (columns 11-12); wherein the distance unit is a track on the storage medium (columns 11-12); a decoding circuit (columns 11-12) selecting one of the relative positions represented in the detected relative position data based on the variable-speed command; and a calculating circuit (columns 11-12) calculating a rotational speed of the motor based on the detected relative position data.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the administrative information of Enokida to the video signal of Naimpally to be recorded and to program Naimpally's system in a manner as taught in Enokida in order to reduce the time in fast playback mode.

The above proposed combination of Naimpally and Enokida does not specifically disclose a plurality of relative position data as recited in claims 23, 33, 42, and 52 and wherein the digital recording medium includes a magnetic medium as recited in claims 26 and 45.

Yuen et al teaches that the VCR has a magnetic tape (column 1, lines 20-30) and that the directory is stored on the tape preferably by writing it repeatedly on a VBI line so that, when the tape is inserted into the indexing VCR, the VCR independently of the point of tape insertion can quickly locate and read a copy of the directory from the VBI line (column 13, lines 20-33).

Art Unit: 2712

It would have obvious to one of ordinary skill in the art at the time of the invention to repeatedly write the administrative information of Enokida on the recording medium of Naimpally so that when the recording medium of Naimpally is inserted into the VCR, the VCR independently of the point of the tape insertion can quickly read the administrative information of Enokida.

It would also have been obvious to one of ordinary skill in the art at the time of the invention to substitute the magnetic tape of Yuen et al for the tape of Naimpally in order to use a single magnetic tape for plurality of times because the magnetic tape has the re-writeable capability.

Response to Arguments

7. Applicant's arguments filed Sept. 29, 1999 have been fully considered but they are not persuasive.

In re pages 6-10, applicants argues that one skilled in the art do not have combined the teachings of Enokida with Naimpally because one skilled in the art would not have been motivated to destroy the recording format carefully constructed by Naimpally to use the less efficient accessing technique discussed above with respect to Enokida and, even assuming such a combination, the claims of the subject application do not read on the resulting art combination because the combination would require the use of a second recording medium in which to store the administrative data.

Art Unit: 2712

In response, as recognized by applicants that Naimpally disclosed compressed video data is decoded and filtered to obtain the low frequency portion of this data for fast playback mode.

Enokida discloses the use of administrative information 60 for fast playback mode.

One of ordinary skill in the art would have been motivated to combine the references as proposed by the Examiner in order to eliminate the use of low frequency portion of the compressed inputted video data of Naimpally. Since the low frequency portion of the compressed inputted video data of Naimpally is eliminated in the combination and the use of the administrative information in Enokida, the time in fast playback mode would be reduce.

Enokida further discloses that the administrative information and moving image data can be stored in one recording medium (column 1, lines 27-31). Thus, the combination of the references would not require the use of a second recording medium.

Even if arguendo that the combination of Naimpally and Enokida required the use of a second recording medium, the combination of Naimpally, Enokida, and Yuen et al would eliminate the second recording medium because Yuen et al specifically disclose that the video and the directory can be recorded in one single recording medium.

In re page 10, applicants also argues that the cited references do not disclose or suggest detecting specific data from the received digital video data wherein the specific data is I-frame data as recited in claim 24.

Art Unit: 2712

In response, it is noted that the administrative information of Enokida includes offset data identifying the position of intra-frames in the moving image data. In order to obtain the administrative information, the intra-frames (I-frames) would be detected. Thus, the proposed combination of the references would teach or suggest the detecting of the I-frames.

Allowable Subject Matter

8. Claims 1-22 would be allowable if filing a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) which identifies the foreign application on which foreign priority is being claimed by specifying the application number, country, day, month, and year of its filing as required by 37 CFR 1.63(c).

Claims 1-22 are consider allowable over the prior art since none of the prior art of record alone or in combination disclose or suggest an apparatus for controlling recording and reproducing in a video cassette tape recorder having frame recording position controlling means for calculating a number of tracks for recording the compressed digital data and selectively outputting a buffered output, the extracted specific data from the frame extracting means and a multiplexing timing signal; frame position information recording means for recording position information of specific tracks for the speed-varied reproduction and index information recording means for recording position information of specific tracks for the speed-varied reproduction and index information on a magnetic tape, based on the multiplexing timing signal; and digital recording means for recording

Art Unit: 2712

digital signals including the digital data and the index information on the magnetic tape as recited in claims 1 and 19 or an apparatus for controlling recording in a video cassette tape recorder having frame recording position controlling means for generating a multiplexing timing signal and multiplexing the compressed digital data and the extracted specific data from the frame extracting means based on the multiplexing timing signal; frame position information recording means for recording index information and position information of specific tracks for recording the specific data for the speed-varied reproduction on a magnetic tape based on the multiplexing timing signal; and digital recording means for recording digital signals including the digital data and specific data from the frame recording position controlling means on the magnetic tape as recited in claims 11 and 21.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2712

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

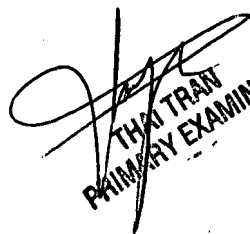
or faxed to:

(703) 308-9051, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


THAI TRAN
PRIMARY EXAMINER

TTQ

December 18, 1999